

Attorney Docket No.: C071

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.: 10/714,493
APPLICANT: Michael D. Hitchcock et al.
FILING DATE: 11/14/2003
TITLE: — Universal Forms Engine

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to the guidelines for Information Disclosure Statements, 37 C.F.R. §§ 1.97-1.98, attached hereto is PTO Form 1449 (three sheets) with references listed for consideration by the Office. Copies of cited US patents are not provided in accordance with the waiver published in the August 5, 2003 Official Gazette. References cited in parent applications are to be reviewed by the Examiner in accordance with MPEP 707.05 and are not separately listed.

In accordance with 37 C.F.R. §§ 1.97(g)-(h), the filing of this Information Disclosure Statement shall not be construed as a representation that a search has been made or an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in 37 C.F.R. § 1.56(b).

This Information Disclosure Statement is being filed before the mailing of a first Office action on the merits.

CERTIFICATE OF MAILING

I hereby certify that this paper or fee is being transmitted via First Class Mail with the United States Postal Service to addressee, United States Patent and Trademark Office, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on June 8, 2004.

By: Margarita Marquez-Escalona
Name: Margarita Marquez-Escalona

Application No.: 10/714,493
Filing Date: November 14, 2003
Applicant: Michael D. Hitchcock et al.
Information Disclosure Statement dated June 8, 2004
Page 2 of 2

In compliance with MPEP 2001.06(c), applicants wish to inform the Examiner that US Pat. Nos. 6,345,278 and 6,640,042, which issued from applications in the priority chain of the present application, were litigated against ApplyYourself, Inc. (US District Court for the District of Oregon, Civil Docket No. CV-02- 484 HU and CV-02-1359 HU). That case is currently on appeal. (Federal Circuit Appeal No. 04-1202).

During the litigation, the defendant ApplyYourself, Inc. unsuccessfully asserted that the asserted claims of both patents were invalid for obviousness and for on-sale activities by XAP Corporation. ApplyYourself, Inc. withdrew the assertion of invalidity as to US Pat. No. 6,640,042 before submission to the jury and the jury found the asserted claims of US Pat. No. 6,345,278 to be valid. To ensure compliance with their duty of disclosure, with regard to the XAP Corporation activities, applicants hereby provide various documents from the litigation, including trial testimony of Mr. Allen Firstenberg of XAP Corporation, trial and deposition testimony of Mr. Frank Tansey, formerly of Sonoma State University, and trial and deposition testimony of Mr. James L. Maraviglia of California Polytechnic State University. Attached to the Maraviglia deposition as an exhibit is a copy of a Contract No. A960014 between XAP Corporation and the Trustees of the California State University. Other documents produced during the litigation and not sealed by the court are included as items PP, QQ, and RR on the attached form PTO/SB/08B.

Additional documents that are described in the testimony are under seal by order of the court at the insistence of XAP Corporation, which refuses to make the additional documents available for submission to the PTO. The attached Contract No. A960014 was obtained from the State of California through a Freedom of Information Act request.

Applicants also submit a copy of an October 12, 2001 Declaration of James H. Wolfston, Jr., which was submitted in previous applications in the priority chain, describing assignee's ApplyWeb I system. Additional research undertaken for the recent litigation has revealed that the date on which ApplyWeb I system was placed on the Internet was probably closer to July 1996, rather than September 1995. Because the July 1996 date is later, and both dates are before

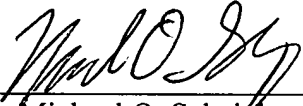
Application No.: 10/714,493
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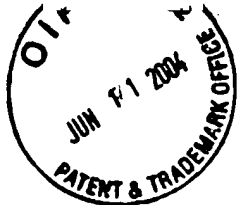
the critical date, applicants submit the error is not material and have not required a new Declaration from the Declarant.

In compliance with MPEP 2001.06(c), applicants also disclose that the patent owner has a pending patent infringement action against XAP Corporation (US District Court for the District of Oregon, Civil Docket No. 03-01229-HU). The patent owner filed, but has since dismissed without prejudice, a patent infringement action against Princeton Review (US District Court for the District of Oregon, Civil Docket No. 03-01231-HU).

Respectfully submitted,

Date: 6/8/04

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PTO/SB/08A (08-03)

Approved for use through 07/31/2006. OMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

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Substitute for form 1449/PTO

**INFORMATION DISCLOSURE
STATEMENT BY APPLICANT**

(Use as many sheets as necessary)

Complete if Known

| | |
|------------------------|----------------------|
| Application Number | 10/714,493 |
| Filing Date | 11/14/2003 |
| First Named Inventor | Michael D. Hitchcock |
| Art Unit | 2127 |
| Examiner Name | N/A |
| Attorney Docket Number | C071 |

Sheet 1 of 3

U. S. PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Document Number | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages or Relevant Figures Appear |
|--------------------|-----------------------|--|--------------------------------|--|---|
| | | Number-Kind Code ² (if known) | | | |
| | A | US- 6,279,112 B1 | 08-21-2001 | O'Toole, Jr. et al. | |
| | B | US- 6,189,029 | 02-13-2001 | Fuerst | |
| | C | US- 6,141,666 | 10-31-2000 | Tobin | |
| | D | US- 6,122,657 | 09-19-2000 | Hoffman, Jr. et al. | |
| | E | US- 6,058,373 | 05-02-2000 | Blinn et al. | |
| | F | US- 6,035,276 | 03-07-2000 | Newman et al. | |
| | G | US- 5,987,480 | 11-16-1999 | Donohue et al. | |
| | H | US- 5,983,227 | 11-09-1999 | Nasem et al. | |
| | I | US- 5,897,622 | 04-27-1999 | Blinn et al. | |
| | J | US- 5,872,640 | 02-16-1999 | Cohen et al. | |
| | K | US- 5,845,075 | 12-01-1998 | Uhler et al. | |
| | L | US- 5,835,712 | 11-10-1998 | DuFresne | |
| | M | US- 5,819,287 | 10-06-1998 | Tsuoka | |
| | N | US- 5,774,670 | 06-30-1998 | Montulli | |
| | O | US- 5,761,673 | 06-02-1998 | Bookman et al. | |
| | P | US- 5,734,887 | 03-31-1998 | Kingberg et al. | |
| | Q | US- 5,717,923 | 02-10-1998 | Dedrick | |
| | R | US- 5,715,453 | 02-03-1998 | Stewart | |
| | S | US- 5,704,029 | 12-30-1997 | Wright, Jr. | |

FOREIGN PATENT DOCUMENTS

| Examiner Initials* | Cite No. ¹ | Foreign Patent Document | Publication Date MM-DD-YYYY | Name of Patentee or Applicant of Cited Document | Pages, Columns, Lines, Where Relevant Passages Or Relevant Figures Appear | T ⁶ |
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| | | Country Code ³ -Number ⁴ -Kind Code ⁵ (if known) | | | | |
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Examiner
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| First Named Inventor | Michael D. Hitchcock |
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| Examiner Name | N/A |
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Sheet 2 of 3

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|--------------------|-----------------------|--|--------------------------------|--|---|
| | | Number-Kind Code ² (if known) | | | |
| | T | US- 5,563,999 | 10-08-1996 | Yaksich et al. | |
| | U | US- 5,455,948 | 10-03-1995 | Poole et al. | |
| | V | US- 5,410,675W | 04-25-1995 | Shreve et al.Y | |
| | X | US- 5,367,619 | 11-22-1994 | Dipaolo et al. | |
| | Y | US- 5,325,478 | 06-28-1994 | Shelton et al. | |
| | Z | US- 5,319,542 | 06-07-1994 | King, Jr. et al. | |
| | AA | US- 5,187,787 | 02-16-1993 | Skeen et al. | |
| | BB | US- 5,129,086 | 07-07-1992 | Coyle, Jr. et al. | |
| | CC | US- 5,077,666 | 12-31-1991 | Brimm et al. | |
| | DD | US- 4,992,940 | 02-12-1991 | Dworkin | |
| | EE | US- 4,831,526 | 05-16-1989 | Luchs et al. | |
| | FF | US- 4,799,156 | 01-17-1989 | Shavit et al. | |
| | GG | US- 4,645,873 | 02-24-1987 | Chomet | |
| | HH | US- 6,421,693 | 07-16-2002 | Nishiyama et al. | |
| | II | US- 6,247,029 | 06-12-2001 | Kelley et al. | |
| | | US- | | | |
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| | | First Named Inventor | Michael D. Hitchcock | | |
| | | Art Unit | 2127 | | |
| | | Examiner Name | N/A | | |
| Sheet | 3 | of | 3 | Attorney Docket Number | C071 |

| NON PATENT LITERATURE DOCUMENTS | | | |
|---------------------------------|-----------------------|---|----------------|
| Examiner Initials* | Cite No. ¹ | Include name of the author (in CAPITAL LETTERS), title of the article (when appropriate), title of the item (book, magazine, journal, serial, symposium, catalog, etc.), date, page(s), volume-issue number(s), publisher, city and/or country where published. | T ² |
| | JJ | S. BING YAO et al., "Formanager: An Office Forms Management System," ACM Transactions on Office Information Systems, Vol. 2, No. 3, July 1984, pages 235-262. | |
| | KK | D. TSICHRITZIS, "Operations and Management-Form Management," Communications of the ACM July 1982, Vol. 25, No. 7, pages 453-478. | |
| ✓ | LL | August 30, 2003 Telephonic Deposition of Frank Tansey, CollegeNET, Inc. v. Apply Yourself, Inc., US District Court for the District of Oregon, No. 02-CV-0484-HU | |
| ✓ | MM | June 18, 2003 Deposition of James L. Maraviglia, CollegeNET, Inc. v. Apply Yourself, Inc. US District Court for the District of Oregon, No. 02-CV-0484-HU, including exhibits not sealed by the court | |
| ✓ | NN | September 2, 2003 trial testimony of Frank Tansey, CollegeNET, Inc. v. Apply Yourself, Inc. US District Court for the District of Oregon, No. 02-CV-0484-HU | |
| ✓ | OO | August 28, 2003 trial testimony of Allen Firstenberg, CollegeNET, Inc. v. Apply Yourself, Inc., US District Court for the District of Oregon, No. 02-CV-0484-HU | |
| ✓ | PP | "A Proposal for the Development and Operation of CSU TeachNet's Online Admission Application Process." Oct. 28, 1998 (CNA07672-CNA7690) | |
| ✓ | QQ | Contract Number A960014 Amendments 4-11, between California State University and XAP Corporation, dated between Feb 3, 1999 to June 25, 2002 (CNA07691-CNA07710) (Original Contract A960014 and amendment 3 included in ref. MM) | |
| ✓ | RR | XAP Corporation Press Release, "XAP Corporation Awarded Contract to Develop State of the Art Student Processing System for the Nation's Largest State- College System, Feb. 12, 1997 | |
| ✓ | SS | August 28, 2003 trial testimony of James L. Maraviglia, CollegeNET, Inc. v. Apply Yourself, Inc., US District Court for the District of Oregon, No. 02-CV-0484-HU | |

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| Examiner Signature | Date Considered |
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